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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/512,734	02/24/2000	Christopher J. Lasher	112764.1101	5298

28089 7590 01/04/2005

WILMER CUTLER PICKERING HALE AND DORR LLP
399 PARK AVENUE
NEW YORK, NY 10022

EXAMINER
SIPOS, JOHN

ART UNIT	PAPER NUMBER
3721	

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/512,734	LASHER ET AL.	
	Examiner	Art Unit	
	John Sipos	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-72* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *1-15,20 and 23-27* is/are allowed.

6)☒ Claim(s) *16-19,21,22&28-72* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The format of the claims submitted in the amendment of September 20, 2004 does not comply with 37 CFR 1.173(b) in that the amendments to claims 16,19 and 22 are not underlined and/or bracketed relative to the original claims of the patent. Also, claim 54 should be completely underlined since it is a new claim. In response to this Office action applicant is required to submit a new copy of the claims in compliance with the above rule.

Since the claims under consideration are the same claims as were presented before the Final rejection and since applicant's arguments have been considered but are not held to be persuasive, the rejections made in the last Office action are repeated.

DRAWINGS

The drawing objection of the last Office action is repeated since new drawings have not been received. In the Remarks section of the Amendment of September 20, 2004 Applicants state that a new set of drawings are included. No such drawings have been received.

The drawings of February 24, 2000 have been objected to by the Draftsperson for the reasons indicated in the attached PTO Form 948. The PTO no longer transfers drawings from the patent file. New drawings are required.

DECLARATION

The rejection of the claims based on defective declaration of the last Office action is repeated since applicant's arguments are not persuasive and new drawings have not been submitted.

The reissue oath/declaration filed with this application is defective because it fails to identify at least one error, which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414. The declaration does not sufficiently specify the error or give a proper example of the error. The examples set forth in the oath are the "omission of broader claims to an operator assisted prescription dispensing system and a method of dispensing pills in a prescription dispensing system". Neither of these is considered as an error in that the claims of the patent inherently apply to an "operator assisted" system and the "method" of operation is set forth in claims 23-27 of the patent.

The Examiner maintains that these do not sufficiently describe the errors on which the reissue application can be based. All machine are "operator assisted" including the machine set forth in the patent as is that patent also a "prescription dispensing system". These are not errors that were made in the prosecution of the patent.

Claims 28-72 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration are set forth in the discussion above in this Office action.

RECAPTURE OF SURRENDERED SUBJECT MATTER

In view of the incorporation of the subject matter of original claim 18 into newly presented claims 28-72 the rejection of the last Office action of the claims under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application has been withdrawn.

REJECTIONS OF CLAIMS BASED ON PRIOR ART

Claims 16 and 46 are rejected under **35 U.S.C. ' 102(b)** as being clearly anticipated by the patent to of Charhut (5,208,762). The patent to Charhut discloses a pill dispensing and packaging machine that comprises of a dispenser 26 having a plurality of pill dispensers containing different pills, computer control means 70 to store prescriptions, to simultaneously control each of the dispensers, to count out and dispense the pills into a package and to stop the dispensers when the desired number of pills are dispensed (column 3, lines 44-62, column 5, line 66 et seq.) and a labeling device 28 labels containers either during or immediately after the pills have been dispensed into the containers (see column 4, lines 1-4) thereby not producing a label for the next prescription until the previous prescription has been dispensed into its container.

Claims 21 and 52 are rejected under **35 U.S.C. ' 102(b)** as being clearly anticipated by the patent to Rowlett (4,953,745). The patent to Rowlett shows a pill dispensing device which comprises of a plurality of pill dispensers containing different pills (34), computer control means (32) to store prescriptions, to simultaneously control

each of the dispensers to count out and dispense the pills into a package (12 and Figure 2) and to stop the dispensers when the desired number of pills are dispensed, indicator 25 that indicates when the number of pills in a dispenser fall below a predetermined minimum (column 4, lines 34-39). The claimed "means to increase" the number of pills when pills are added to the dispenser is read on the portion of the computer that also tracks the number of pills remaining in each dispenser and as such reflects the numeric change whenever pills are removed or added to the dispenser (column 10, lines 39-43).

Claim 28-45,54 and 55-72 are rejected under **35 U.S.C. ' 102(b)** as being clearly anticipated by the patents to Shimizu or Rowlett or Charhut. Each of these patents (see specific descriptions above) discloses a pill dispensing machine that comprises of a plurality of pill dispensers containing different pills, computer control means to store prescriptions, to simultaneously control each of the dispensers to count out and dispense the pills into a package and to stop the dispensers when the desired number of pills are dispensed. In each operation an input device allows an operator to store prescription information on the machine computer which then controls the operation of the dispensers so that simultaneous dipensing of the different pills can take place from the different dispensers according the stored prescriptions. The machine sequentially dispenses the pills according to the prescription responsive to a predetermined command from the computer or action of the operator.

Claim 49-51 are rejected under **35 U.S.C. ' 102(b)** as being clearly anticipated by the patent to Charhut.

Claim 17 and 19 are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Charhut (5,208,762) in view of Merrill (3,139,713). The patent to Charhut does not disclose the use of a plurality of output hoppers and snouts. The patent to Merrill shows a dispensing machine which comprises of a dispensing hopper 76, a mechanical counting means 83,93, a plurality of output hoppers 86, a plurality of snouts 48 aligned in a row, and means 89 controlled by the central control system to selectively permit the release of the pills from the output hoppers, through the snouts and into the containers to expedite the dispensing operation. It would have been obvious to one skilled in the art to provide Charhut with an in-line output/snout system as shown by Merrill to expedite the filling of the containers.

Claim 18 is rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Charhut (5,208,762). The use of an "on" light indicating that a specific mechanism is operating is well known in the art and it would have been obvious to one skilled in the art to provide the dispensers of Charhut with means to indicate that an individual dispenser of Charhut is operating.

Claims 16,18 and 46 are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Shimizu (4,664,289) in view of Charhut (5,208,762). The patent to Shimizu discloses a pill dispensing and packaging machine that comprises of a plurality of pill dispensers containing different pills (3), computer control means (1C) to store prescriptions, to simultaneously control each of the dispensers to count out and dispense the pills into a package (12 and Figure 2) and to stop the

dispensers when the desired number of pills are dispensed. The Shimizu machine lacks the use of a printer as claimed. The patent to Charhut shows a pill dispensing /counting/packaging device which comprises a pill dispenser 26 that fills containers and a labeling device 28 that labels them either during or immediately after the pills have been dispensed into the container (see column 4, lines 1-4). It would have been obvious to one skilled in the art to label the packages of Shimizu after the filling operation so that a label will not be produced for the next prescription until after pills specified in a preceding prescription have been received in the package. Regarding claim 18, the use of an "on" light indicating that a motor is operating is well known in the art and it would have been obvious to one skilled in the art to provide the dispenser of Shimizu with means to indicate that an individual motor 48 of the dispensers of Shimizu is operating.

Claim 17 is rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Shimizu (4,664,289) in view of Charhut (5,208,762), as applied above, and further in view of Merrill (3,139,713). The patents to Shimizu and Charhut do not disclose the use of a plurality of output hoppers and snouts. The patent to Merrill shows a dispensing machine which comprises of a dispensing hopper 76, a mechanical counting means 83,93, a plurality of output hoppers 86, a plurality of snouts 48 aligned in a row, and means 89 controlled by the central control system to selectively permit the release of the pills from the output hoppers, through the snouts and into the containers to expedite the dispensing operation. It would have been obvious to one skilled in the art to provide Shimizu-Charhut with an in-line output/snout system as shown by Merrill to expedite the filling of the containers.

Claims 16-18 and 46 are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the admitted prior art (APA) of the IDS of 10/10/2000 in view of Charhut (5,208,762). The IDS sets forth on page 2, second paragraph, a pill dispensing and packaging machine that comprises of a plurality of adjacent pill dispensers (such as the one disclosed by Hurst in Patent No. 4,869,394) containing different pills and computer control means to store prescriptions and to simultaneously control each of the dispensers to count out and dispense the pills into an accumulating hopper controlled by a sliding door. The APA machine lacks the use of a printer as claimed. The patent to Charhut shows a pill dispensing /counting/packaging device which comprises a pill dispenser 26 that fills containers and a labeling device 28 that labels them either during or immediately after the pills have been dispensed into the container (see column 4, lines 1-4). It would have been obvious to one skilled in the art to label the packages of APA after the filling operation so that a label will not be produced for the next prescription until after pills specified in a preceding prescription have been received in the package. Regarding the plurality of “snouts” these read on the output tube set forth in APA. Regarding claim 18, the use of an “on” light indicating that a motor is operating is well known in the art and it would have been obvious to one skilled in the art to provide the dispensers of APA with means to indicate that an individual dispenser is operating. Since the IDS is not completely clear on the structure of the APA, applicants are requested to submit any other information available on the this device.

Claim 19 is rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the admitted prior art (APA) of the IDS of 10/10/2000. The IDS sets forth on page 2, second

paragraph, a pill dispensing and packaging machine that comprises of a plurality of adjacent pill dispensers (such as the one disclosed by Hurst in Patent No. 4,869,394) containing different pills and computer control means to store prescriptions and to simultaneously control each of the dispensers to count out and dispense the pills into an accumulating hopper controlled by a sliding door. Regarding the plurality of "snouts" these read on the output tube set forth in APA. Regarding claim 18, the use of an "on" light indicating that a motor is operating is well known in the art and it would have been obvious to one skilled in the art to provide the dispensers of APA with means to indicate that an individual dispenser is operating.

Claims 22 is rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Rowlett. The use of bar code labels and readers to reflect the number and type of pills in a supply is well known in the art and using such a counting process when adding pills from a bulk supply to the dispensers of Rowlett would have been obvious to one skilled in the art to keep track of the number of pills being added as well as to keep track of the number of pills being removed from the bulk supply.

Claims 47 and 49-51 are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patents to Shimizu or Rowlett or Charhut. The use of a "ready" signal indicating that a specific mechanism completed its operation is well known in the art and it would have been obvious to one skilled in the art to provide the dispensers of Shimizu or Rowlett or Charhut with means to indicate that an individual dispenser is ready. Regarding claims 49-51, these patents do not disclose the filling of bottles by the dispensers but since the filling of bottles with pills is well known it would have been

obvious to one skilled in the art to provide bottles under the dispensers of the machines of these references.

Claim 48 and 53 are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Charhut (5,208,762) in view of Merrill (3,139,713). The patent to Charhut does not disclose the use of a plurality of output hoppers and snouts. The patent to Merrill shows a dispensing machine which comprises of a dispensing hopper 76, a mechanical counting means 83,93, a plurality of output hoppers 86, a plurality of snouts 48 aligned in a row, and means 89 controlled by the central control system to selectively permit the release of the pills from the output hoppers, through the snouts and into the containers to expedite the dispensing operation. It would have been obvious to one skilled in the art to provide Charhut with an in-line output/snout system as shown by Merrill to expedite the filling of the containers.

RESPONSE TO APPLICANTS' ARGUMENTS

Applicants' argues that the references do not disclose the simultaneous counting and the sequential dispensing of articles.

Each of the references used in rejecting the claims shows an article dispensing means that comprises a plurality of dispensing units, each including a counter and a computer controller controlling said plurality of units and counters. Since applicants have specifically stated on page 2 of the Remarks section of the August 20, 2003 Amendment and page 34 of the September 20, 2004 Amendment that "the changes recited in these claims eliminate language that could give rise to "means plus function"

interpretation.", the applied reference need not specifically disclose the claimed function but merely set forth the structure. It is only the structure set forth in the claims that need be shown by the references and little patentable weight is afforded to the functional language unless it is set forth in "means plus function" terms and 35USC112, sixth paragraph, is invoked.

Applicants' arguments and the cited decisions on page 44 of the September 20, 2004 Amendment are directed to the interpretation of claims prior to the Donaldson decision of 1994. The Court of Appeals for the federal Circuit decided in its decision *In re Donaldson Co.,* 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994) that if 35USC112, sixth paragraph is invoked then the structure in the specification corresponding to the claimed structure and function cannot be disregarded. However, if 35USC112, sixth paragraph is not invoked, the claims are given their broadest interpretation. The structures recited in the above rejected claims are shown by the references and are capable of performing the claimed functions. The functions have been considered but they do not add any structure to that which was already set forth in the claims.

Newly cited patent to Gross discloses a system for automatic discharge of articles that can be operated in different modes one of which is the simultaneous counting of articles and their sequential dispensing.

ALLOWABLE SUBJECT MATTER

Claims 1-15,20 and 23-27 are allowed.

MISCELLANEOUS PAPERS

The objections made under the heading of Miscellaneous Papers in the last Office action are repeated. In the Remarks section of the Amendment of September 20, 2004 Applicants state that these papers are included. No such papers have been received.

This application is objected to under 37 CFR 1.172(a) as lacking a proper written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01. A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

This is a continuation of applicant's earlier Application No. 09512734. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to **Examiner John Sipos** at telephone number **(703) 308-1882.** The examiner can normally be reached from 6:30 AM to 4:00 PM Monday through Thursday.

The **FAX** number for Group 3700 of the Patent and Trademark Office is **(703) 872-9306**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703) 308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 308-1148.

John Sipos
Primary Examiner
Art Unit 3721